

AMENDMENT
U.S. Appl. No. 09/823,458

REMARKS

By this amendment Applicant cancels claims 24, 30 and 36 thus claims 23, 25-29, 31-35 and 37 are all the claims pending in the application. All claims stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and the remarks the follow.

CLAIM REJECTIONS

Claims 23-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over, previously cited U.S. Patent 6,397,040 to Titmuss et al. (hereinafter "Titmuss"). Applicant respectfully traverses these rejections for the following reasons.

The rejections in the instant Office Action are based on incorrect assertions regarding the teachings of Titmuss. For example, the Office Action alleges Titmuss discloses *sending consumer information to a portable communication device wherein the consumer information is selected based at least in part on a vendor's proximity to the reference location and one or more criteria specified by a user from the portable device*. Respectfully there is no teaching or suggestion in Titmuss that the user preference data (stored by personal agent 6 in a regional server) is every specified by a user from the portable device. In fact, Titmuss is entirely silent on how the user's preference data is recorded but it is clear that this data is pre-stored in a regional server. Col. 6, ll. 54-56. Thu Titmuss does not teach or suggest each limitation claimed by Applicant, and *prima facie* anticipation has not been established.

Further the Office Action asserts, with regard to claim 24, that Titmuss discloses a system which *receives the one or more criteria specified by the user from the portable communication device substantially at the same time of identifying the reference location*. Again, Applicant

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respectfully submits this interpretation is incorrect. Apart from the fact that the personal preferences of Titmuss are stored in a regional server (and thus do not appear to even come from the portable communication device itself), there is absolutely no indication in Titmuss that this data would be received at substantially at the same time of identifying a reference location as claimed by Applicant. Applicant believes this position is well founded and demonstrated by the absence in the Office Action of any citation in the Titmuss document which corresponds to this limitation.

Further, in regard to the limitations of claims 25 and 30, the Office Action cites Titmuss col. 6, ll. 57-62 as disclosing *criteria* (specified by the user) *that pertain to at least one of price, a distance or a quality for vendor goods or services*. Applicant respectfully submits Titmuss's reference to user preferences including "location-based preferences" is far to general to anticipate Applicant's limitation of distance. For example, "location-based preferences" may simply mean a name of a town or address.

Because Titmuss fails to teach or disclose the identical invention in as complete detail as claimed by Applicant, Titmuss cannot anticipate any of Applicant's claims. See MPEP 2131 and *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

In regard to the obviousness rejection, Applicant respectfully reminds the Examiner that, it is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

It is respectfully submitted that, by the Examiner's own admission, Titmuss does not disclose the limitations present in Applicant's claims 27, 32 and 34. Instead, the Office Action

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apparently relies on what is known by the skilled artisan to establish *prima facie* obviousness. However, since Titmuss does not in fact disclose or suggest identifying a reference location comprises receiving a location input into the portable device by the user, Titmuss alone cannot render claim 27 obvious. MPEP 2143.

Additionally, the Office Action is incorrect the Titmuss suggests storing user specified criteria in a memory of the wireless communication device. In fact, Titmuss specifically teaches away from this limitation by disclosing that a user's preference data (stored as a personal agent 6) are stored in the regional server. Accordingly, *prima facie* obviousness is not established with regard to claim 32.

Lastly, the Office Action admits Titmus fails to disclose the limitation of claim 34 that *the user specified criterion includes at least one of a price range for an amount of fuel or a minimum distance to travel*. The Office Action instead alleges Titmuss "suggests" these features because Titmuss suggests a user's list preference could be anything desired by a user. Applicant respectfully submits that the Office Action deficient on two accounts: (i) Titmuss does not suggest a user's list "could be anything desired by the user"; and (ii) any such generalization is still insufficient to establish *prima facie* obviousness as the specific limitations claimed by Applicant are simply not disclosed or suggested by the cited prior art reference.

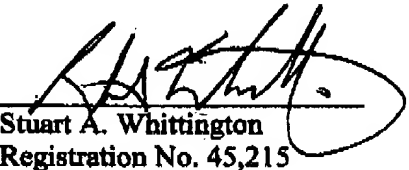
For the foregoing reasons, Applicant respectfully submits the claims were improperly rejected. Notwithstanding, Applicant has amended the independent claims to further clarify inventive embodiments for the Examiner. Applicant submits these amendments are not necessary to establish patentability but are presented to expedite prosecution of the application. Accordingly, reconsideration and withdrawal of the 102 and 103 rejections of record are respectfully requested.

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CONCLUSION

In view of the foregoing allowance of this application is believed to be in order, and such action is hereby solicited. If any issues arise which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221**.

Respectfully submitted,


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